

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Attorney Docket No. 7056-X09-004

Raphael MECHOULAM et al. : Confirmation No. : 7062

Application No.: 10/597,166 : Inter. App. No.: PCT/IL05/000053

Filed: July 13, 2006 (371 date)

Title: *THERAPEUTIC USE OF QUINONOID DERIVATIVES OF CANNABINOIDS*

RENEWED PETITION UNDER 37 C.F.R. §1.137(a) AND ALTERNATIVE PETITION
UNDER 37 C.F.R. §1.137(b) TO REVIVE

Mail Stop: Office of PCT Legal Administration
Attention: George Dombroske
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Dombroske:

In reply to the Petition Decision dated January 11, 2010, Applicants hereby petition for revival of the above-identified patent application.

Table of Contents for this Petition

Petition (5 pages) - Begins on page 2.

- Section I: Exhibit List (page 2)
- Section II: Prosecution History (pages 2-4)
- Section III: Case for Revival (page 4)
- Section IV: Conclusion (pages 4-5)

I. Exhibit List

- Exhibit A: Copy of Notification of Abandonment Dated September 28, 2009 (1 page)
- Exhibit B: Copy of Notification of Missing Requirements Dated July 21, 2008 (3 pages)
- Exhibit C: Copy of Response to Notification of Missing Requirements Dated August 31, 2008 (9 pages)
- Exhibit D: Copy of Decision Dated November 7, 2008 (2 pages)
- Exhibit E: Copy of Response to Decision Dated December 5, 2008 (31 pages)
- Exhibit F: Copy of Letter of Transfer of File Dated February 24, 2009 (2 pages)
- Exhibit G: Copy of Revocation and New Power of Attorney Dated March 17, 2009 (5 pages)
- Exhibit H: Copy of Notice of Acceptance of Power of Attorney Dated September 28, 2009 (1 page)
- Exhibit I: Copy of Petition for Revival of Application Dated November 16, 2009 (7 pages)
- Exhibit J: Copy of Corrected, Executed Declaration Submitted November 16, 2009 (6 pages)
- Exhibit K: Copy of Petition Decision Dated January 11, 2010 (2 pages)
- Exhibit L: List of Documents Included in the Image File Wrapper of Application Serial Number 10/597,166 as obtained from Public PAIR on January 22, 2010 (3 pages)

II. Prosecution History

Applicants contend that abandonment of the above-identified application was unavoidable. Thus, in accordance with 37 C.F.R. §1.137(a), Applicants respectfully petition the Commissioner to revive this application. The Notification of Abandonment, dated September 28, 2009 (Exhibit A), states that the reason for abandonment is “*Applicant’s failure to properly respond to the Notification of Missing Requirements (Form PCT/DO/EO/905) and Decision dated November 7, 2008. The Declaration filed on December 5, 2008 looks like a composite. Pages 4 and 5 are the same sheet, signed by different inventors then combined to make a single document.*”

The application in question, the U.S. National Stage of International Application PCT/IL2005/000053, was filed on July 13, 2006 by Applicants’ prior representatives, Marsteller & Associates.

On July 21, 2008, a Notification of Missing Requirements under 35 U.S.C. §371 in the United States Designated/Elected Office (DO/EO/US) was mailed to Applicants (Exhibit B). This Notification states that submission of a fee in the amount of \$745 for additional claims, a proper Declaration/Oath compliant with 37 C.F.R. §1.497(a) and (b), and a Sequence Listing

compliant with 37 C.F.R. §1.821 and 1.825 is required to complete acceptance under 35 U.S.C. §371.

On August 31, 2008, Applicants filed a Response to the Notification contesting the submission requirements and requesting withdrawal of the Notification (Exhibit C).

On November 7, 2008, a Decision was mailed to Applicants (Exhibit D). This Decision withdraws the requirement for submission of a Sequence Listing, but affirms the propriety of the other submission requirements set forth in the Notification (additional claim fee and a proper Oath/Declaration).

On December 5, 2008, Applicants filed a Response to the Decision, including a new Declaration, a fee in the amount of \$745 for additional claims, and a Preliminary Amendment (Exhibit E).

In February 2009, at the request of the assignee, Yissum Research Development Company of the Hebrew University of Jerusalem, responsibility for prosecution of the application in question was transferred from Marsteller & Associates to Applicants' new (and current) representatives, Fleit Gibbons Gutman Bongini & Bianco P.L. The letter of transfer is attached hereto as Exhibit F.

On March 17, 2009, Applicants' new Representatives filed a Revocation and New Power of Attorney (Exhibit G).

On September 28, 2009, the Notice of Acceptance of Power of Attorney was mailed to Applicants (Exhibit H) officially establishing the new Representatives as "attorneys of record." As noted above, the Notification of Abandonment was also mailed on September 28, 2009 (Exhibit A).

On November 16, 2009, Applicants filed a Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unavoidably under 37 C.F.R. §1.137 (a) (Exhibit I). This Petition included a petition form, a fee in the amount of \$810, and a corrected, executed Declaration compliant with 37 C.F.R. §1.497(a) and (b). The Declaration is attached separately as Exhibit J.

On January 11, 2010, a Petition Decision was mailed to Applicants (Exhibit K). This Decision indicates that, although the Declaration (Exhibit J) is acceptable, the Petition is dismissed as the petitioner has paid the fee pertaining to a Petition under 37 C.F.R. §1.137(b), as opposed to the proper fee under 37 C.F.R. §1.137(a) and further, the petitioner has not provided an adequate showing that the entire delay in filing the required reply was “unavoidable” within the meaning of 37 C.F.R. §1.137(a).

A list of the documents included in the Image File Wrapper of the application in question, obtained from public PAIR on January 22, 2010, is provided herewith as Exhibit L to corroborate the dates noted above in the prosecution history.

III. Case for Revival of Application

First, there is no indication in the electronic records of PAIR (Exhibit L) that the Office ever informed Applicants that the Declaration filed on December 5, 2008 was unacceptable. Therefore, Applicants could not have known, prior to abandonment, that a requirement for submission of a corrected Declaration was outstanding.

Furthermore, the Notification of Abandonment (Exhibit A) and the Notice of Acceptance of Power of Attorney (Exhibit H) were both mailed on the same date, September 28, 2009. Thus, even if Applicants had known about the outstanding requirement for a corrected Declaration, no action could be taken as Applicants’ Representatives were not officially “attorneys of record” until the date of abandonment. Therefore, the application was abandoned before Applicants’ Representatives could properly take action.

IV. Conclusion

Applicants believe that the proper fee for this Petition is \$270 in accordance with 37 C.F.R. §1.17(l). However, with the prior Petition of November 16, 2009, Applicants paid the fee of \$810 in accordance with 37 C.F.R. §1.17(m). Therefore, in the event that this Petition is granted, Applicants respectfully request a refund of the \$540 overpayment.

Considering that the proper fee has been paid and reasons supported by evidence (Exhibits A-L) that the entire delay in filing the required reply (for submission of a corrected

Declaration) was unavoidable have been presented, Applicants respectfully submit that this Petition is now in compliance with all requirements for granting revival of the application.

In the alternative, in the unlikely event that this petition is not granted, Applicants respectfully request that this petition be considered a petition under 37 C.F.R. §1.137(b) to revive an unintentionally abandoned patent application. Accordingly, please apply the previous payment of \$810 as the required petition fee for an unintentionally abandoned patent application. In this regard, Applicants certify that the entire delay in filing the required reply (corrected Declaration) from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. §1.137(b) was unintentional. Because this application was filed after June 8, 1995, a terminal disclaimer is not required for revival.

The Commissioner is hereby authorized to charge any other fees that may be required or credit any refund/overpayment to Deposit Account **500601**.

Respectfully submitted,
/Martin Fleit/

Date: February 3, 2010

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